

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 33-400 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, on the grounds of multiplicity. In support of this contention, the Examiner cited M.P.E.P. § 2173.05(n), stating that:

[a]n unreasonable number of claims, that is, unreasonable in view of the nature and scope of Applicant's invention and the state of the art, may afford a basis for a rejection on the ground of multiplicity. A rejection on this ground should include all the claims in the case inasmuch as it related to confusion of the issue.

Relying on this, the Examiner stated that Applicants should elect 50 claims for the purposes of examination. Applicants respectfully disagree with the Examiner's reasoning and traverse this rejection.

The United States Court of Customs and Patent Appeals (CCPA) has held that the Applicant is allowed to determine the number and scope of the claims, provided that the Applicant pays the required fees and otherwise operates within the statutory requirements. *In re Wakefield*, 422 F.2d 897, 901. Applicants are aware of no statutory requirements that require Applicants to limit the number of claims to 50. Applicants have also paid the required fees for prosecuting the pending claims. Thus, Applicants have followed permissible caselaw and statutory requirements and merely added a prudent set of claims of a different scope by which to protect their invention. Applicants respectfully request that the Examiner withdraw the rejection of claims 33-400.

The Examiner further rejects claims 33-400 as subject matter which repeats "what is already claimed and patented" in light of U.S. Patent 5,932,540. Applicants respectfully disagree.

Independent claims 33, 49, 65, 81, 97, 113, 129, 145, 161, 177, 193, 209, 225, 241, 257, 273, 289, 305, 321, 337, 342, 347, 352, 357, 368, 379, and 390 recite the language "at least 90% identical," while the subject matter claimed and patented in U.S. Patent 5,932,540 does not.

Each of the dependent claim sets contained within the instant application claim subject matter different from that of U.S. Patent 5,932,540. Furthermore, each dependent claim set contained within the instant application claims subject matter different in scope than

the remaining dependent claims. Thus, the instant application does not claim subject matter already claimed and patented.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the indefiniteness rejection of claims 33-400 under 35 U.S.C. § 112, second paragraph. Applicants have demonstrated that the pending claims do not cloud the issue to the extent that would warrant a continuation of the multiplicity rejection. Applicants may submit as many claims as may be deemed necessary, provided that Applicants pay the necessary fees and otherwise operate within the statutory requirements. Furthermore, Applicants have shown that the pending claims recite the language "at least 90% identical," in contrast to the claims of U.S. Patent 5,932,540 which do not recite this language. Thus, the pending claims are not directed to subject matter that is already claimed and patented.

Conflicting Claims

The Examiner rejected the protein claims of the present application as conflicting with the protein claims of Application No. 09/219,442, according to 37 CFR 1.78 (b). See Paper No. 8, Page 4.

Applicants respectfully disagree.

The pending protein claims of the instant application do not conflict with the protein claims of Application No. 09/219,442, because the protein claims of the instant application recite, or depend from independent claims that recite, the language "at least 90% identical," whereas the protein claims of Application No. 09/219,442 are drawn to, or depend from independent claims that claim, products made by a particular process.

For the same reasons stated above, the protein claims of the instant application are different in both subject matter and scope from the protein claims of pending Application No. 09/219,442.

Similarly, the Examiner rejected the method claims of the present application as conflicting with claims 22-110 of Application No. 09/107,997, and with the method claims of Application No. 09/219,442, according to 37 CFR 1.78 (b). See Paper No. 8, Page 4.

Applicants respectfully disagree.

The pending method claims of the instant application do not conflict with claims 22-110 of Application No. 09/107,997, or with the method claims of Application No. 09/219,442, because the method claims of the instant application depend from claims reciting

"at least 90% identical," whereas the method claims of Application No. 09/219,442 depend from products made by a particular process, and while pending claims 22-110 of Application No. 09/107,997 are directed to a method of stimulating angiogenesis using VEGF-2 polypeptides (wherein the VEGF-2 polypeptides can be made by any process).

For the same reasons stated above, the method claims of the instant application are different in both subject matter and scope from claims 22-110 of pending Application No. 09/107,997, as well as the method claims of pending Application No. 09/219,442.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection to pending claims 33-400 of the instant application as conflicting with pending claims 22-110 of Application No. 09/107,997, and the protein and method claims of Application No. 09/219,42, according to 37 CFR 1.78 (b).

Conclusion

In view of the foregoing remarks, Applicants believe they have fully addressed the Examiner's concerns and that this application is now in condition for allowance. An early notice to that effect is urged. A request is made to the Examiner to call the undersigned at the phone number provided below if any further action by Applicants would expedite allowance of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Michele M. Wales
Michele M. Wales (Reg. No. 43,975)
Attorney for Applicants

Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
Telephone: (301) 610-5772

Enclosure
MW/RL/lcc